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EXAMINER

GUARRIELLO, JOHN J

ART UNIT	PAPER NUMBER
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1771

25

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 08/976820
Filing Date: 11/25/1997
Appellant(s): JORN LEIBER ET AL.

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GROUP 1700

Kurt G. Brisco
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 1/31/2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

Art Unit: 1771

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect.

The pending claims are 20-33. The rejected claims are 20-31. The allowed claims are 32 and 33.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct.

The changes are as follows: Upon review of the brief, it is agreed that claims 32 and 33 are patentable over the applied prior art. The rejected claims are 20-31.

Art Unit: 1771

(7) *Grouping of Claims*

The Examiner disagrees with the statement that the claims on appeal do not stand or fall together. It is the Examiner's position that the article claims 20-30 stand together and the method claims 31-33 stand together. However, it is noted that applicant argues claims 20-26, claims 27-30 and method claims 31-33 as groups.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct. The pending claims are 20-33. The rejected claims are 20-31.

Claims 32 and 33 are allowed.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,725,923	LUHMANN	3-1998
5,622,761	COLE	4-1997

Art Unit: 1771

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luhmann 5,725,923 in view of Cole 5,622,761.

Luhmann describes double sided adhesive film, (see abstract). Luhmann describes these films are removable adhesive films, and tabs can be incorporated, like with grips to hold, on the films, (column 2, lines 6-67). Luhmann describes that tabs can be designed in order to facilitate the removal of the adhesive film, (column 2, lines 65-67). Luhmann differs from the claimed invention with regard to the shape of the regions of the adhesive tape, and the placement of the tabs in the regions.

Art Unit: 1771

Cole describes doublesided adhesive tape with releaseable adhesive, (see abstract). Cole describes the adhesives can be single bodies or plural bodies.

Cole describes the adhesives can be disposed in different geometrical shapes: like circles, ovals, rectangles (like a quadrangle), polygons (like triangles), and other shapes, (see abstract; column 3, lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the shapes of the regions of adhesive tape of Cole in order to modify the shapes of the adhesive regions of Luhmann and the placement of the tabs in the regions motivated with the expectation that the rearranging of the parts of the claimed invention involves only routine skill in the art as illustrated by Cole, see *In re Japikse*, 86 USPQ 70.

(11) Response to Argument

Applicant's arguments regarding the grip tabs and the number of sides has been reviewed and considered, but they are not persuasive because Luhnann describes grip tabs, (column 2, lines 65-67). Further, it is known to have tabs

Art Unit: 1771

with ends uncoated, (column 2, line 67; column 3, lines 1-3). Even though Luhmann describes tabs may not be necessary, as applicant argues, Luhmann describes that a tab is recommended in each case to enable easier pulling on the residue and such a tab can be designed so that non-adhesive areas can extend around the edge of the piece of adhesive, (column 2, lines 65-67; column 3, lines 1-2).

Applicant's argument that there is no motivation for combining the references has been considered but is not persuasive because it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements (like tabs and number of tabs) that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art, like adhesives, *In re Sheckler*, 168 USPQ 716 (CCPA 1971); *In re McLaughlin* 170 USPQ 209 (CCPA 1971); *In re Young* USPQ 159 USPQ 725 (CCPA 1968).

Applicant's argument regarding improper hindsight has been considered but is not persuasive, because it must be recognized that any judgment on

Art Unit: 1771

obviousness is in a sense necessarily a reconstruction based upon knowledge which was within the level of ordinary skill at the time the claimed invention was made, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Improper hindsight was not employed because the combination of Luhmann does describe grip tabs and suggests the number of grip tabs can be equal to the sides of the polygon shaped adhesive and that it would be obvious to one of ordinary skill to rearrange parts as noted above in the grounds of rejection.

Applicant's arguments regarding the method claims 31-33 have been considered. The arguments are persuasive regarding claims 32-33 since the manipulative step of "pulling the at least two grip tabs apart diametrically in the plane of said bond" is not described. Claims 32 and 33 are allowable.

Regarding claim 31, the method of forming a bond between an adhesive tape section and a substrate would be obvious as noted above.

Art Unit: 1771

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Patent Examiner
April 18, 2002



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